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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,612	12/02/2005	Michihiro Izumi	03500.018183.	1506
5514	7590	03/04/2009	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MURRAY, DANIEL C	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/559,612	IZUMI, MICHIIRO	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANIEL C. MURRAY	2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 November 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 34-42 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 34-42 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 17NOV2008.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This Action is in response to Applicant's amendment filed on 17NOV2008. **Claims 34-42** are now pending in the present application. **This Action is made FINAL.**
2. **Claims 1-33** have been canceled by Applicant.

### ***Information Disclosure Statement***

3. The information disclosure statements submitted on 17NOV2008 have been considered by the Examiner and made of record in the application.

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

➤ **Claims 40-42 line 1**, the claim terminology “computer-usable medium having control logic” lacks proper antecedent basis.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 34-36 and 40-42** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. **Claims 35-36 and 41-42** are rejected by virtue of their dependency on **claims 34 and 40** respectively.

**Claim 34** states: A communication apparatus including a **facsimile communication unit** adapted to perform facsimile communication on a line switching network and an Internet Protocol (IP) **communication unit**, transmit communication data to a communication partner station discriminated by a telephone number, and receive communication data from the communication partner station, the apparatus comprising: an IP address **obtaining unit** adapted to obtain an IP address of the communication partner station from a Session Initiation Protocol (SIP) proxy server, based on a telephone number of the communication partner station; and a control unit adapted to establish a Voice over IP (VoIP) communication channel on an IP network according to the IP address of the communication partner station obtained by the IP address **obtaining unit**, ...

**Claim 40** states: **A computer-usable medium** having control logic stored therein for causing a communication apparatus to implement a control method, wherein the communication apparatus includes a facsimile communication unit adapted to perform facsimile communication on a line switching network and an Internet Protocol (IP) communication unit, transmit communication data to a communication partner station discriminated by a telephone number, and receive communication data from the communication partner station, the control method comprising: an IP address obtaining step of obtaining an IP address of the communication partner station from a Session Initiation Protocol (SIP) proxy server, based on the telephone number of the communication partner station; and a control step of establishing a Voice over IP (VoIP) communication channel on an IP network according to the IP address of the communication partner station obtained by the IP address obtaining unit,...

**Applicant's specification** states: [0059] FIGS. 7 to 9 are flow charts respectively showing communication control procedures to be executed by the image communication apparatus 105 or 107. Here, it should be noted that the communication control procedures shown in FIGS. 7 to 9 are stored as control programs of the CPU 201 in the ROM 202, and the stored programs are actually executed by the CPU 201. However, the location where the program for achieving the communication control procedure according to the present embodiment is not limited to the ROM. Moreover, the **present embodiment is not limited to the case where the program has been stored in the ROM from the beginning**, that is, the program may be supplied and updated through another storage medium **or a network**.

Applicant attempts to claim non-statutory subject matter (i.e. software/signals). **Claim 34** is directed towards an apparatus comprising “units” which appear to be software and **claim 40** is directed towards a computer usable medium which appears to equate a storage medium with a network (see paragraph [0059], wherein the program can be supplied of updated through a network) which appears to be a signal. Applicant fails to claim a proper computer readable medium and thus fails to fall within a statutory category and is thus, *per se*, considered software/signal.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 34-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chimura et al. (US Patent # US 6,400,719 B1)** in view of **Strauss et al. (US Patent # 5,940,598)** in view of **Mussman et al. (US Patent Publication # US 2004/0139209 A1)** in further view of **Nada (US 2002/0095516 A1)**.

a) Consider **claims 34, 37, and 40**, Chimura et al. clearly show and disclose, a communication apparatus, control method, and computer-readable medium including an Internet Protocol (IP) communication unit, transmit communication data to a communication partner station discriminated by a telephone number, and receive communication data from the communication partner station (figure 1, figure 7, abstract, column 2 lines 1-38), the apparatus, method, and computer readable medium comprising: an IP address obtaining unit adapted to obtain an IP address of the communication partner station from a proxy server, based on a telephone number of the communication partner station (figure 1, figure 7, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34); and a control unit adapted to establish a Voice over IP (VoIP) communication channel on an IP network according to the IP address of the communication partner station obtained by the IP address obtaining unit, and to transmit an image transmission request message prior to transmission of image data (figure 1, figure 7, abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 15-34, column 5 lines 45-67, column 6 lines 1-3), wherein, based on an image

transmission permission message received from the communication partner station, in response to the image transmission request message, in a case where transmission of communication data on the IP network based on a predetermined file transmission protocol can be performed, the control unit starts transmission of the image data between the communication apparatus and the communication partner station on the IP network based on the predetermined file transmission protocol using the obtained IP address of the communication partner station (abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34), and wherein, based on the image transmission permission message received from the communication partner station, in response to the image transmission request message, in a case where reception of the communication data on the IP network based on a predetermined file reception protocol can be performed, the control unit starts reception of the image data between the communication apparatus and the communication partner station on the IP network based on the predetermined file reception protocol using the obtained IP address of the communication partner station (abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34). However, Chimura et al. does not specifically disclose a facsimile communication unit adapted to perform facsimile communication on a line switching network and an Internet Protocol (IP) communication unit, obtaining an IP address of the communication partner station through SIP (Session Initiation Protocol), in a case where transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and in a case where reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel.

Strauss et al. show and disclose a universal or multipurpose network server having enhanced processing functions which are performed in association with a telecommunications network to provide multi-mode communications via a combination of the public switched telephone network (PSTN) and a public packet data network, such as the Internet, wherein a facsimile communication unit adapted to perform facsimile communication on a line switching network and an Internet Protocol (IP) communication unit (figure 4, abstract, column 1 lines 57-61, column 7 lines 23-29 lines 40-53, column 8 lines 10-20).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate a facsimile communication unit adapted to communicate on a line switching network and IP network, as taught by, Strauss et al. into the system of Chimura et al. for the purpose of for the purpose of transmitting a facsimile signal (Strauss; column 7 lines 23-29). However, Chimura et al. as modified by Strauss et al. does not specifically disclose obtaining an IP address of the communication partner station through SIP (Session Initiation Protocol), in a case where transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and in a case where reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel.

Mussman et al. show and disclose an apparatus which includes a device configured to support a first protocol for initiation, maintenance, and termination of a communication session between call endpoints, and to support a second protocol for resolving endpoint addresses for the

communication session wherein, obtaining an IP address of the communication partner station is accomplished by using SIP (Session Initiation Protocol)(abstract, paragraph [0003], [0013], [0014]).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate using SIP (Session Initiation Protocol), as taught by, Mussman et al. into the system of Chimura et al. as modified by Strauss et al. for the purpose of initiation, maintenance, and termination of a communication session (Mussman; abstract). However, Chimura et al. as modified by Strauss et al. as modified by Mussman et al. does not specifically disclose in a case where transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and in a case where reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel.

Nada show and disclose an Internet telephone system and an Internet telephone apparatus using the Internet wherein an IP address obtaining means judges by analyzing the telephone number of the communication partner whether or not the communication with the communication partner station through a VoIP transmission path is possible wherein, in a case where transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel (abstract, paragraph [0028], [0052], [0058], [0064]), and in a case where reception of the communication data on the IP network based on the predetermined file reception protocol cannot

be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel (abstract, paragraph [0028], [0052], [0058], [0064]).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate communicating using determining whether or not the communication through a VoIP transmission path is possible, as taught by, Nada into the system of Chimura et al. as modified by Strauss et al. as modified by Mussman et al. for the purpose of for the purpose of analog facsimile communication when communication on the IP network based on the predetermined file reception protocol cannot be performed (Nada; paragraph [0064]).

b) Consider **claims 35, 38, and 41, and as applied to claims 34, 37, and 40 above,** Chimura et al. as modified by Strauss et al. as modified by Mussman et al. as modified by Nada clearly show and disclose, the communication apparatus, control method, and computer-readable medium according to claim 34, 37, and 40, wherein the IP address obtaining unit judges whether a communication can be performed with the communication partner station via the VoIP communication channel, by interpreting the telephone number of the communication partner station (Nada; abstract, paragraph [0028], [0052], [0058], [0064]), and wherein, in a case where the communication cannot be performed with the communication partner station via the VoIP communication channel, the IP address obtaining unit calls the communication partner station on the line switching network and causes the facsimile communication unit to perform analog facsimile communication (Nada; abstract; paragraph [0028], [0052], [0058], [0064]).

c) Consider **claims 36, 39, and 42, and as applied to claims 34, 37, and 40 above,** Chimura et al. as modified by Strauss et al. as modified by Mussman et al. as modified by Nada clearly show and disclose, the communication apparatus, control method, and computer-readable

medium according to claim 34, 37, and 40, wherein the IP address obtaining unit judges whether a communication can be performed with the communication partner station via the VoIP communication channel, by interpreting the telephone number of the communication partner station (Nada; abstract, paragraph [0028], [0052], [0058], [0064]), and wherein, in a case where the communication can be performed with the communication partner station via the VoIP communication channel, the IP address obtaining unit tries to obtain the IP address of the communication partner station from the SIP proxy server (Chimura; abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34, Mussman; (discloses using SIP to set up communications) paragraph [0003], [0013], [0014]).

***Response to Arguments***

9. Applicant's arguments with respect to **claims 34-42** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 2003/0107776 A1
- US 2002/0018236 A1
- US 2001/0014910 A1
- US 2001/0000441 A1
- US 7,215,438 B2
- US 6,785,266 B2
- US 6,671,063 B1
- US 6,618,165 B1
- US 6,603,569 B1
- US 6,477,243 B1
- US 6,437,873 B1
- 6,058,169
- US 7,453,606 B2
- US 7,289,618 B2
- US 7,245,391 B2
- US 7,057,755 B2
- US 6,891,826 B2

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MURRAY whose telephone number is 571-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571)-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DCM/  
Examiner, Art Unit 2443

/J Bret Dennison/  
Primary Examiner, Art Unit 2443